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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/572,747	03/21/2006	Kouichi Noguchi	NOGU3002/GAL	3332
23364 7590 08/17/2010 BACON & THOMAS, PLLC 625 SLATERS LANE FOURTH FLOOR ALEXANDRIA, VA 22314-1176				
EXAMINER				
HENKEL, DANIELLE B				
ART UNIT		PAPER NUMBER		
1797				
MAIL DATE		DELIVERY MODE		
08/17/2010		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/572,747

Applicant(s)

NOGUCHI ET AL.

Examiner

DANIELLE HENKEL

Art Unit

1797

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 May 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 3 and 4 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3-4 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/C)
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 5/24/10 has been entered.
2. Claims 1 and 3-4 remain pending.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).
6. Claims 1 and 3-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over KANEGASAKI (2003) in view of KITAGAWA (US 4629862).
 - a. With respect to claim 1, KANEGASAKI discloses a cell observation chamber comprising a dish-shaped bottom support body with a window for observing the movement of cells provided in the center of a bottom part thereof; a glass substrate adapted to be placed on a bottom surface of said bottom support body; a dish-shaped intermediate support body with an opening formed in the center of a bottom part thereof, said intermediate support body being adapted to be attached to said bottom support body to press and fix said glass substrate from above onto the bottom surface of said bottom support body; a substrate with a plurality of through holes for guiding cell suspension containing solution chemotactic factor containing solution therethrough, said substrate being adapted to be fixed onto a surface in the central part of said glass substrate, said substrate having at least a pair of wells and a flow path for fluid communication

between said wells formed in a surface facing said glass substrate; a packing member with a plurality of through holes for guiding said cell suspension containing solution and said chemotactic factor containing solution therethrough, said packing member being adapted to be fitted into said opening portion that is formed in the center of the bottom part of said intermediate support body to press said substrate from above; a dish-shaped cover block body with a plurality of through holes for guiding said cell suspension containing solution and said chemotactic factor containing solution therethrough formed in the center of the bottom part thereof, said cover block body being adapted to be attached to said bottom support body with said intermediate support body attached thereto to press and fix said substrate from above onto said glass substrate through said packing member (Sections 2.1, 2.2, 2.5 and Figure 1). KANEGASAKI does not explicitly disclose a solution temperature control device. However, KITAGAWA discloses a cell observation chamber and a solution temperature control device comprising a temperature sensor with a temperature sensing part immersed in a solution within said cell observation chamber to directly measure the temperature of solutions filling the wells (Column 8, lines 2-6) and a temperature controller controlling the temperature of the solutions to be a predetermined temperature with feedback (Column 3, lines 4-8, Column 8, lines 47-67) of the measured temperature (Column 8, line 17- Column 9, line 54; Figure 5 and 7). KITAGAWA also discloses the temperature controller for measuring the temperature of a heating section external to the cell observation chamber (Column 8, lines 6-16)

that heats the cell observation chamber from outside thereby indirectly heating the solutions filling the wells and for controlling the heating section (heater plate) to be a predetermined preheating temperature (Column 8, line 17-Column 9, line 45). KITAGAWA further discloses a changeover switch that switches connection of the heater between the controller with connection to the first sensor and the controller with the connection to the second sensor so that the heater is controlled by either the feedback from the first or second sensors (Column 8, line 47-Column 9, line 45). At the time of the invention it would have been obvious to one of ordinary skill in the art to modify the device of KANEGASAKI to include the solution temperature controller and sensors as taught by KITAGAWA because a more precise temperature control is achieved in which the temperature controller controls the temperature of the sample so as to control the part of the sample to be at a present temperature (Column 9, lines 38-45, Column 3, lines 17-20). While KITAGAWA does not explicitly disclose two separate temperature sensors, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use two identical controllers to perform the same function as KITAGAWA's one controller, since it has been held that mere duplication of the essential working part of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8. An additional temperature controller connected to the second sensor would have the expected result from perform the same function as having both sensors on a switch connected to one controller (see Figure 6), in that in both

cases only one sensor is directly connected to the controller at a time for controlling the heater with temperature feedback.

b. With respect to claim 3, KITAGAWA discloses the temperature controller prevents the heating section from being overheated (controlled to preset temperature) (Column 9, lines 24-32).

c. With respect to claim 4, the combination of KANEGASAKI and KITAGAWA above discloses the limitations of claim 1. KITAGAWA additionally discloses an alternative placement of a temperature sensor (first sensor) for directly measuring the temperature of solutions filling a pair of wells (Figure 7, Column 9, lines 46-54), the temperature sensor being attached detachably to the cell observation chamber (microtest plate)(Column 9, lines 11-13), and having a temperature sensing part immersed in solution in a liquid storage chamber (cell) formed in the cell observation chamber in an isolated position where the solution therein is indirectly heated by the heating section equally with the solutions in a well (other cell) and where the liquid storage chamber is separate (different cell) and connected to wells (connected via plate) (Column 9, lines 46-54 and Figure 7).

Response to Arguments

7. Applicant's argument pages 6-8, that KITAGAWA fails to explicitly disclose two separate temperature controllers, has been considered and is persuasive. However, a new rejection over KITAGAWA due to design choice has been made. While KITAGAWA

does not explicitly disclose two separate temperature sensors, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use two identical controllers to perform the same function as KITAGAWA's one controller, since it has been held that mere duplication of the essential working part of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8. An additional temperature controller connected to the second sensor would have expected results from perform the same function as having both sensors on a switch connected to one controller (see Figure 6), in that in both cases only one sensor is directly connected to the controller at a time for controlling the heater with temperature feedback.

8. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the first and second controllers controls the temperatures in real time) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIELLE HENKEL whose telephone number is (571)270-5505. The examiner can normally be reached on Mon-Thur: 11am-8pm, Alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Marcheschi can be reached on 571-272-1374. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

DBH

/William H. Beisner/
Primary Examiner, Art Unit 1797